Supreme Court, U.S.
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No. 05-

IN THE

Supreme Court of the United States

SKF USA INC.,

Petitioner,

v.

INTERNATIONAL TRADE COMMISSION, BEARINGS LIMITED, and MCGUIRE BEARING COMPANY,

Respondents.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

PETITION FOR A WRIT OF CERTIORARI APPENDIX

Volume I of II (pp. 1a-120a)

BENNETT EVAN COOPER
STEPTOE & JOHNSON LLP
Collier Center
201 East Washington Street
Suite 1600
Phoenix, AZ 85004-2382
(602) 257-5200

HERBERT C. SHELLEY
Counsel of Record
ALICE A. KIPEL
STEPTOE & JOHNSON LLP
1330 Connecticut Ave., N.W.
Washington, D.C. 20036
(202) 429-8146

Counsel for Petitioner

200153

COUNSEL PRESS
(800) 274-3321 • (800) 359-6859

QUESTION PRESENTED

Does the Lanham Act prohibit, as trademark infringement, the sale of imported gray market goods that are materially different from all but a very small percentage of the trademark owner's legitimate goods authorized for sale under the mark in the United States?

RULE 29.6 STATEMENT

Petitioner SKF USA Inc., a United States corporation, is a wholly owned subsidiary of AB SKF, a publicly owned corporation trading on the Swedish stock exchange.

Respondents are the United States International Trade Commission, Bearings Limited, and McGuire Bearing Company.

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PETITION FOR WRIT OF CERTIORARI

SKF USA Inc. ("SKF USA") respectfully petitions for a writ of certiorari to review the judgment of the United States Court of Appeals for the Federal Circuit in this case.

OPINIONS BELOW

The opinion of the court of appeals is reported at 423 F.3d 1307 (Fed. Cir. 2005) (Pet. App. 1a-23a). The order of the court of appeals denying the petition for rehearing and rehearing en banc is unreported. 2005 U.S. App. LEXIS 29264 (Fed. Cir. Dec. 23, 2005) (Pet. App. 523a-524a).

The final determination of the United States International Trade Commission ("ITC"), styled *Certain Bearings and Packaging Thereof*, Inv. No. 337-TA-469, is published at 2004 ITC LEXIS 473 (Int'l Trade Comm'n June 30, 2004) (Pet. App. 24a-120a). Notice of the decision was issued by the ITC on May 12, 2004, and published in the *Federal Register* on May 18, 2004 (69 Fed. Reg. 28,155), with the determination being issued thereafter on May 24, 2004.

The initial determination of the presiding Administrative Law Judge at the ITC, which issued on April 10, 2003, is published at 2003 ITC LEXIS 321 (2003) (Pet. App. 121a-522a), with additional findings of fact pursuant to the ITC's remand order, issued on December 30, 2003, published at 2003 ITC LEXIS 794.

The appendices accompanying this petition are public versions. Confidential versions of the ITC and ALJ documents are available should the Court so request.

JURISDICTION

The court of appeals denied SKF USA's petition for rehearing and rehearing en banc on December 23, 2005 (Pet. App. 523a-524a). The jurisdiction of this Court is invoked under 28 U.S.C. § 1254(1) (2000).

STATUTORY PROVISIONS INVOLVED

Sections 337(a)(1)(A) and (C) of the Tariff Act of 1930, as amended, 19 U.S.C. §§ 1337(a)(1)(A) and (C), setting forth the unfair practices in import trade which are at issue herein and actionable under Section 337, and Sections 32(1)(a) and 43(a)(1)(A) of the Trademark Act of July 5, 1946, as amended, (the "Lanham Act"), 15 U.S.C. §§ 1114(1)(a) and 1125(a)(1)(A), declaring as unlawful the unfair trade practices of infringement of a registered trademark and false designation of origin, respectively. These statutes are reproduced at Pet. App. 525a-530a.

STATEMENT

A. Introduction

This petition presents a pressing circuit conflict over the legal standard for trademark infringement by "gray market" goods manufactured abroad and bearing the trademark owner's mark but imported for resale in this country without the trademark owner's consent. Gray market goods may differ from authorized goods in both physical characteristics and nonphysical characteristics, such as accompanying warranties and post-sale services. There is a great risk that consumers who see the trademark affixed to gray market goods will be confused or deceived and will not recognize that the goods lack the full set of attributes of authorized goods.

Most circuits therefore hold that if there are "material differences," whether physical or nonphysical, between the gray market imports and the trademark owner's authorized goods, sale of the gray market goods is "likely to cause confusion, or to cause mistake, or to deceive" and thereby infringe the trademark under 15 U.S.C. §§ 1114(1)(a) and 1125(a)(1)(A). *See generally* J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 29:51.2 (4th ed. 2005). The Lanham Act protects United States trademark owners from infringement of their marks by such gray market